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REMARKS

In the Office Action, the Examiner made a requirement for election of species. The Examiner identified the following sets of species:

- I. There are several species of radial hinge mechanisms including Figs. 1-4f, Figs. 5a and 5b, and each of figures 14-16;
- II. Several different species of spokes;
- III. Several different species of spoke connections including figure 6, figure 7 and 8 and figures 9-11b; and
- IV. Many species of structures holding the radial hinge mechanisms apart and/or structures including a radial hinge mechanism such as those in each of Figs. 27-54.

Applicant hereby elects the following species with traverse:

- I. Figs. 1-4f;
- II. Spoke 102/402;
- III. Figs. 7 and 8; and
- IV. Fig. 43.

The elected species include all of the claims. Further, all of the claims are generic.

Applicant submits that the restriction requirement is improper for several reasons. Specifically, the Examiner (1) has confused the interpretation of Figs. 5a and 5b; (2) has not provided a clear and detailed record of the restriction requirement; and (3) has not applied the proper standards for restricting between species. Additionally, the Examiner has not identified any generic claims, and in particular, has not identified independent claims 1, and 31 as generic claims, even though these claims all clearly read on each of the alleged "species" identified by the Examiner.

The Examiner has confused the interpretation of Figs. 5a and 5b, which show the same embodiment as shown in Figs. 4a-4f only just moved into a different position. It should be noted that this embodiment is movable into different positions. Thus, the embodiment shown in

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Figs. 5a-5b is the same as in Figs. 4a-4f and cannot be considered a different species. Accordingly, the claims corresponding to Figs. 1-5b should all be examined at this time.

Applicant respectfully submits that the Examiner has not complied with all the requirements for setting forth a proper restriction requirement. M.P.E.P. (8th ed., Rev. 4) § 814 states that an Examiner must provide a clear and detailed record of the restriction requirement. More specifically, this section of the Manual of Patent Examining Procedure states:

The Examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 U.S.C. § 121. *Geneva Pharms. Inc. v. Glaxosmithkline PLC*, 349 F.3d 1373, 1381, 68 U.S.P.Q. 2d 1865, 1871 (Fed. Cir. 2003). *See also* M.P.E.P. § 804.01. (Emphasis in original).

Moreover, with respect to the restriction between species, M.P.E.P. § 814(I) states:

Particular limitations in the claims and the reasons why such limitations are considered to support restriction of the claims to a particular disclosed species should be mentioned to make the requirement clear.

M.P.E.P. (8th ed., Rev. 4) § 806.01 states that it is the claimed subject matter that must be considered when making a restriction requirement rather than the disclosure. Specifically, M.P.E.P. § 806.01 states:

In passing upon the questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter **must** be compared in order to determine the question of distinctness or independence. (Emphasis added).

Here, the Examiner has not pointed to any claim limitations and further has not identified any of the claims. For that matter, the Examiner has failed to provide any reasons why any claim limitations are considered to support restriction of the claims to a particular disclosed species.

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More specifically, with respect to the species pertaining to spokes, the Examiner has not identified any of the alleged different species. Applicant has elected spokes 102/402 insofar as these spokes are identical with the exception of the ends of the spokes constituting part of the connectors, which is the subject of another species restriction. Per the election of the alleged species shown in Figs. 7 and 8 pertaining to the connectors, it is noted that the connector shown uses spoke 402.

M.P.E.P. § 808.01(a) states provides further guidance. Specifically, this section of the M.P.E.P. states:

Where there is no disclosure of a relationship between species (see M.P.E.P. § 806.04(B)), they are independent inventions. A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the Examiner if a restriction is not required.  
*See M.P.E.P. §§ 803 and 808.02.*

Where there is a relationship disclosed between species, such disclosed relation *must* be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction. (Emphasis added).

Here the Examiner has not discussed nor advanced any reasons leading to the conclusion that the disclosed relation does not prevent restriction.

For the reasons stated above, the restriction requirement based on species is not set forth in sufficient detail to be proper, and thus must be withdrawn.

For such a restriction of species to be proper, it is incumbent upon the Examiner to show that each of the species claims defines characteristics of the invention that are mutually exclusive of one of the characteristics defined in the other species claims, and thus that the claims do not overlap in scope. M.P.E.P. § 806.04(E) defines “species” as follows:

*Species are always the specifically different embodiments.*

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M.P.E.P. § 806.04(f) sets forth the requirements for making a proper restriction based on species. Specifically, M.P.E.P. § 806.04(f) states:

Where two or more species are claimed, a requirement for restriction to a single species may be proper *if the species are mutually exclusive*. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, *the claims must not overlap in scope*. (Emphasis added).

Here the claims clearly overlap in scope. Each of the distinguishing features of the alleged "species" could be combined in a single system, and are therefore not mutually exclusive features relative to one another. In particular, independent claims 1 and 31 do not exclude a radial hinge mechanism where the spokes are connected by spoke end connectors. Claims 6-9, 13 and 14 are evidence of this. Likewise, independent claims 1 and 31 do not exclude different forms of elongated members or spokes. Claims 3, 4, 33, and 34 are evidence of this. Because the claims do not exclude any one species from falling within their scope, all of the claims overlap in scope and do not define mutually exclusive characteristics. Thus, all the claims are generic.

For the reasons stated above, Applicant respectfully submits that the requirement for election of species is improper and should be withdrawn. A Notice to this effect is therefore respectfully solicited.

Respectfully submitted,  
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